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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,902	09/27/2001	Mark S. Roby	2791	3232

7590

03/24/2004

Chief Patent Counsel
United States Surgical
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EXAMINER

JACKSON, GARY

ART UNIT PAPER NUMBER

3731

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/964,902

Applicant(s)

ROBY ET AL.

Examiner

Gary Jackson

Art Unit

3731

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on February 9, 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.


The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 24-27.Claim(s) withdrawn from consideration: 1-23.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet


Gary Jackson
Primary Examiner
Art Unit: 3731

Continuation of 10. Other: Status of Appeal claims including claim 25, which was omitted in the Final Office Action.

This action is a supplemental to the Final Office Action mailed November 6, 2003. This action now clearly indicates the status of claim 25.

For purposes of Appeal, claims 24-27 are pending; claims 1-23 have been cancelled.
Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 24 is rejected under 35 U.S.C. 102(b) as being anticipated by Bendel et al (US Patent 4,959,068). The Bendel et al reference is used here as in the previous Office Action mailed May 21, 2003. The reference discloses each of the limitations recited in the claims. The function recited in the whereby clause is capable of being performed by Bendel et al since there's no structure difference between the claim and the reference.

The examiner believes that the rejections is proper and therefore remain.

Claim Rejections - 35 USC § 103

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bendel et al in view of Granger et al (US Patent 5,458,616). The Bendel et al patent discloses each of the limitations recited in the claim except for the particular material. Granger et al teaches the use of aminoalkyl siloxane to coat a surgical needle. It would have been obvious to one having ordinary skill in the art to use aminoalkyl siloxane to coat Bendel et al since it is well known in the art and readily available.

Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Granger et al '616 or (Granger et al 5,258,013) in view of Bartrug et al (US Patent 6,025,025). The latter reference suggests using the known concept of coating metal using silicone coating having an interpenetrating network. It is within the purview of one having ordinary skill in the art to look to Bartug et al for a silicone or a method in coating metal with silicone. Once the concept is known, it would not matter for what purpose the silicone-coated metal is used for.

The examiner believes the action is proper and the references alone or in combination meet the limitations of the claims.

GARY JACKSON
PRIMARY EXAMINER
GROUP 3300

3/22/04 